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10/074,665	02/13/2002	Thomas J. Kennedy III	P-4628-3-C1-3-C1	8236

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EXAMINER

GORDON, RAEANN

ART UNIT PAPER NUMBER

3711

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14

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GROUP 3700

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 14

Application Number: 10/074,665
Filing Date: February 13, 2002
Appellant(s): KENNEDY ET AL.

Michelle Bugbee
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9-11-03.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) Grouping of Claims

Appellant's brief includes a statement that claims 46-53 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,431,193	NESBITT	2-1984
6,359,066	YABUKI	3-2002
5,098,105	SULLIVAN	3-1992

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 46-50, 52, and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Nesbitt (4,431,193). Regarding claims 46, 47 and 50, Nesbitt discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer. The inner cover layer is made from a hard, highly flexural modulus resinous material such as Surlyn 1605, which has a Shore D hardness of 62 (see Yabuki 6,359,066). The outer cover layer is made from a soft, low flexural modulus resinous material such as Surlyn 1855 (ionomer), which has a Shore D hardness of 55 (see Yabuki 6,359,066, col 11). The spin factor is inherent since

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the materials are the same. Regarding claims 48 and 49, the inner cover layer thickness is from 0.020 to 0.070 inch and the outer cover layer thickness is from 0.020 to 0.100 inch (fig 2). Regarding claim 52, the inner cover layer material has a flex modulus of 44,961 psi (Yabuki 6,359,066, col 11). Regarding claim 53, the coefficient of restitution of the core is 0.770 and the coefficient of restitution of the core and inner cover layer is 0.800 or more. Applicant's COR, 0.770 or more, for the ball is an inherent feature of Nesbitt.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt in view of Sullivan (5,098,105). Nesbitt discloses the invention as shown above but does not disclose an ionomer for the outer layer with a flex modulus from 1,000 to 10,000 psi. Sullivan teaches an ionomer for a cover layer with a flex modulus from 2500 to 3500 psi (col 9, line 47). One skilled in the art would have modified the outer layer material to increase the durability of the golf ball.

Claims 46-53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,213,894. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention is anticipated by the '894 patent.

(11) *Response to Argument*

The present invention claims (independent claim 46) a golf ball comprising a core and an inner cover layer with a Shore D hardness of at least 60 formed from a composition which includes at least one material selected from the group

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consisting of polyphenylene ether/ionomer blends, ionomers, polyamides, polyurethanes, polyester elastomers, polyester amides, metallocene catalyzed polyolefins, and blends thereof. The golf ball also includes an outer cover layer with a Shore D hardness of no more than 55 and overall spin factor of at least 5. The primary reference, Nesbitt, discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer. The inner cover layer is made from Surlyn 1605 (ionomer), which has a Shore D hardness of 62 (see Yabuki 6,359,066, col. 11). The outer cover is made from Surlyn 1855, which has a Shore D hardness of 55 (see Yabuki 6,359,066, col. 11). Appellant disagrees with two aspects of the rejection set forth above.

First, Appellant argues Nesbitt does not disclose or claim a specific Shore D hardness or limit the cover to materials having a specific Shore D hardness. Appellant's position is completely misunderstood. Nesbitt clearly discloses the inner and outer cover layers are made from Surlyns 1605 and 1855, respectively (col. 2, lines 35-45). Surlyns 1605 and 1855 are tradenames for specific ionomer resins that are commercially available and have specific properties, such as Shore D hardness. The Yabuki reference is cited to teach the inherent properties of Surlyns 1605 and 1855. Column 11 of Yabuki clearly teaches Surlyns 1605 and 1855 have Shore D hardness values of 62 and 55, respectively. Although Appellant's arguments are silent with respect to the Yabuki reference the Examiner notes, "extra references or evidence can be used to show an inherent characteristic of the thing taught by the primary reference" MPEP 2131.01 III. With respect to the claimed ranges of the inner cover layer and the outer cover

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layer, specific examples in the prior art which are within a claimed range anticipates the range MPEP 2131.03. In the instant case, Appellant claims an inner cover layer Shore D hardness of 62 and an outer cover layer Shore D hardness of no more than 55 (55 or less). Nesbitt discloses an inner cover layer made from Surlyn 1605, which inherently has a Shore D hardness of 62 and an outer cover layer made from Surlyn 1855, which inherently has a Shore D hardness of 55. "[W]hen, as by a recitation of ranges or otherwise, a claims covers several compositions, the claim is anticipated if *one* of them is in the prior art." *Titanium Metals Corp v. Banner*, 778 F 2d 775, 227 USPQ 773 (Fed Cir. 1985).

Appellant's second argument focuses on the claimed spin factor of at least 5. Appellant argues the burden is on the Examiner to provide a basis in fact and/or technical reason to reasonably support the determination that the allegedly inherent characteristics flow from the teachings of the prior art. In the previous office actions the technical reasoning is abundantly clear. Applicant's claimed golf ball is identical to the golf ball disclosed by Nesbitt therefore the properties must also be identical. Appellant is reminded that once a reference teaching product appearing to be substantially identical is made the basis of a rejection, and the Examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference MPEP 2112. In the instant case the Examiner has provided reasoning supporting inherency throughout the entire prosecution of the case. However,

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appellant has not advanced arguments showing that the present invention is materially different from the prior art.

Appellant does not set forth arguments regarding dependent claims 47 to 50, 52, and 53. However, as shown throughout the prosecution and as set forth above, Nesbitt clearly discloses the claimed subject matter. Regarding claim 47, the spin factor is inherent since the materials are the same as shown above. Regarding claims 48, the outer cover layer thickness is from 0.020 to 0.100 inch (fig 2). Regarding claim 49, the inner cover layer thickness is from 0.020 to 0.070 inch (fig 2). Regarding claim 50, the inner cover layer is made from a hard, highly flexural modulus resinous material such as Surlyn 1605, which is an ionomer. Regarding claim 52, the inner cover layer material has a flex modulus of 44,961 psi (Yabuki 6,359,066, col 11). Regarding claim 53, the coefficient of restitution of the core is 0.770 and the coefficient of restitution of the core and inner cover layer is 0.800 or more. Therefore, Appellant's COR, 0.750 or more, for the ball is an inherent feature of Nesbitt. Furthermore, the materials are identical as well.

In regards to dependent claim 51 Appellant submits that the Examiner has failed to make a *prima facie* case of obviousness. As support Appellant states Sullivan discloses a single cover layer formed from a blend of ionomers and does not disclose a multi-layer cover with a flex modulus from 1,000 to 10,000 psi. However, the rejection is based on a material (Iotek 7520) in the Sullivan reference and not the entire reference. The primary reference, Nesbitt, discloses each limitation except the flex modulus from 1,000 to 10,000 psi for the outer

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cover layer. However, Nesbitt does state the outer cover layer must be made from a soft, low flexural modulus resinous material (col. 2, lines 44-46). Sullivan teaches a soft ionomer resin with a flexural modulus from 2500-3500 psi (low to one skilled in the art) (col. 9, lines 5-10, 44-47). Since Nesbitt clearly discloses the outer cover layer must be made from a soft, low flexural modulus resin and Sullivan teaches a soft low modulus resin the motivation to modify Nesbitt in view of Sullivan is clear to one of ordinary skill in the art. Moreover, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Therefore, Appellant's arguments with respect to the limitations of Sullivan that are inconsistent with Nesbitt are not relevant. For example, Appellant states the ionomer blend of Sullivan produces a cover with a Shore D hardness of 64 and 60, wherein the blend is Iotek 7520, 4000, and 8000. However, as previously stated the reference (Sullivan) is cited for the Iotek 7520 which has a flex modulus from 2500 to 3500 psi. Also Iotek 7520 has a Shore D hardness from 32 to 36. The Shore D hardness and flex modulus values parallel the disclosure of Nesbitt, which requires the outer cover layer to be made from a soft, low flexural modulus resin.

In conclusion, it is submitted that Nesbitt expressly and inherently discloses independent claim 46. Nesbitt, discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer. The inner cover layer is made from Surlyn 1605, which has a Shore D hardness of 62 (see Yabuki 6,359,066,

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col. 11). The outer cover is made from Surlyn 1855, which has a Shore D hardness of 55 (see Yabuki 6,359,066, col. 11). Although Appellant's arguments are silent with respect to the Yabuki reference which teaches the inherent properties of the Surlyns the Examiner notes, "extra references or evidence can be used to show an inherent characteristic of the thing taught by the primary reference" MPEP 2131.01 III. Since the material make-up of the golf ball disclosed by Nesbitt is identical to Appellant's the spin factor is also inherent. With respect to dependent claim 51, Nesbitt, discloses each limitation except the flex modulus from 1,000 to 10,000 psi for the outer cover layer. However, Nesbitt does state the outer cover layer must be a soft, low flexural modulus resinous material (col. 2, lines 44-46). Sullivan teaches a soft ionomer resin with a flexural modulus from 2500-3500 psi (low to one skilled in the art) (col. 9, lines 5-10, 44-47). Since Nesbitt clearly discloses the outer cover layer must be made from a soft, low flexural modulus resin and Sullivan teaches a soft low modulus resin the motivation to modify Nesbitt in view of Sullivan is clear to one of ordinary skill in the art.

For the above reasons, it is believed that the rejections should be sustained.

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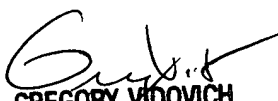
Respectfully submitted,




Rachean Gordon
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Art Unit 3711

rg
January 22, 2004

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